

## REMARKS

This Application has been carefully reviewed in light of the Non-Final Office Action mailed October 13, 2010. At the time of the Office Action, Claims 1-3 and 20-60 were pending in this Application. Claims 2, 3 and 41-56 were previously withdrawn due to an election/restriction requirement. Claims 1, 6-18, 20-40, and 57-60 were rejected. Claims 1, 10, 18, 20, 29, 33, 35, 58-59 have been amended to further define various features of Applicants' invention. Claim 57 has been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §102**

Claims 1, 4-9, 17-26, 28-30, 33-34 and 57-60 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0163126 by West ("West"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 1, claim 17, and claim 29, Applicants submit that West does not describe an active electrode disposed on a first portion of a port edge as well as a return electrode disposed on a second portion of a port edge; an edge being defined as a line at which two surfaces meet. In contrast, West appears to describe at least one of the electrodes disposed at a location away from a port edge. As such, West does not describe all of the elements of amended claim 1, claim 17 and claim 29, and therefore cannot anticipate claims 1, 17 or 29, as amended. For at least these reasons, Applicants respectfully submit that claims 1, 17, and 29 are in condition for allowance, and request withdrawal of the rejection.

Claims 6-9 and 58 all depend directly or indirectly from claim 1. Claims 18, 20-26 and 28 all depend directly or indirectly from claim 17. Claims 30, 33 and 34 all depend directly from claim 29. Applicants hereby repeat and incorporate the comments made above with regard to amended claims 1, 17, and 29. For at least these reasons, Applicants submit that claims 4-9, 18-26, 28, 30, 33-34 and 58-60 are in condition for allowance, and respectfully request withdrawal of the rejection.

With regard to claim 59, West does not describe an active electrode disposed on at least a portion of an edge of the tissue port as well as a return electrode spaced proximally away from the port; an edge being defined as a line at which two surfaces meet. In contrast, West appears to describe at least one of the electrodes disposed at a location away from a port edge. As such, West does not describe all of the elements of claim 59 as amended, and therefore cannot anticipate amended claim 59. For at least these reasons, Applicants respectfully submit that claim 59 is in condition for allowance, and request withdrawal of the rejection.

Claim 60 depends directly from claim 59. Applicants hereby repeat and incorporate the comments made above with regard to amended claim 59. For at least these reasons, Applicants submit that claim 60 is in condition for allowance, and respectfully request withdrawal of the rejection.

### **Rejections under 35 U.S.C. §103**

Claims 10, 12, 15-16, 35-37 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of U.S. Patent Application Publication No. 2002/0038122 by Peters (“Peters”).

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claim 10 above, and further in view of U.S. Patent No. 4,203,444 issued to Bonnell et al. (“Bonnell”).

Claims 13 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent Application Publication No. 2001/0025177 by Woloszko et al. (“Woloszko”).

Claims 14 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent No. 5,423,844 issued to Miller (“Miller”).

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 17 above, and further in view of Miller.

Claims 31 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 29 above, and further in view of U.S. Patent No. 6,032,673 issued to Savage et al. (“Savage”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With regard to claim 10 and claim 35, none of the cited references at least suggest an active electrode disposed on at least a first portion of an edge of the port as well as a return electrode disposed on a second portion of the tissue removal port edge. As such, none of the cited references, alone or in combination, at least suggest all of the elements of amended claims 10 or 35. Therefore, the cited references cannot render obvious claims 10 and 35 as amended. For at least these reasons, Applicant respectfully submits that amended claims 10 and 35 are in condition for allowance, and request withdrawal of the rejection.

Claims 12, 15 and 16 all depend directly from claim 10. Claims 36, 37 and 39 all depend directly from claim 35. Applicants hereby repeat and incorporate the above comments with regard to amended claims 10 and 35. For at least these reasons, Applicants submit that claims 12, 15, 16, 36, 37, and 39 are in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 11, 13 and 14 all depend directly from claim 10. Claims 38 and 40 depend directly from claim 35. Applicants hereby repeat and incorporate the comments made above with regard to amended claims 10 and 35. Specifically, none of the cited references at least suggest all of the elements of amended claims 10 and 35, in that they do not suggest an active electrode disposed on at least a portion of an edge of the port as well as a return electrode disposed on a second portion of the tissue removal port edge. Because none of the cited references, alone or in combination, at least suggest all of the elements of claim 10 or claim 35, the cited references cannot render obvious these claims. For at least these reasons, Applicants submit that claims 11, 13, 14, 38 and 40 are in condition for allowance, and respectfully request withdrawal of the rejection.

Regarding claim 27, which depends from claim 17, applicants hereby repeat and incorporate the comments made above with regard to amended claim 17. Specifically, the cited references do not at least suggest all of the elements of amended claims 17, in that they neither suggests an active electrode disposed on a first portion of an edge of the tissue removal port, nor does it suggest a return electrode disposed on a second portion of the tissue removal port edge. Because none of the cited references, alone or in combination, at least suggest all of the elements of claim 17, and thereby claim 27, the cited references cannot render obvious these claims. For at least these reasons, Applicants submit that claim 27 is in condition for allowance, and respectfully request withdrawal of the rejection.

Regarding claims 31 and 32, which depends from claim 29, applicants hereby repeat and incorporate the comments made above with regard to amended claim 29. Specifically, the cited references do not at least suggest all of the elements of amended claims 29, in that they neither suggests an active electrode disposed on a portion of an edge of the tissue removal port, nor does it suggest a return electrode disposed on a second portion of the tissue removal port edge. Because none of the cited references, alone or in combination, at least suggest all of the elements of claim 29, and thereby claims 31 and 32, the cited references cannot render obvious these claims. For at least these reasons, Applicants submit that claims 31 and 32 are in condition for allowance, and respectfully request withdrawal of the rejection.

**New Claim**

New claim 61 has been added to further describe the present disclosure.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS and any additional fees necessary and/or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
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Date: 10 JAN 2011

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Enclosure: 1) Information Disclosure Statement and PTO Form 1449.